

PATENT
BRENDA 5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Brenda Pomerance Confirmation: 7218
Filed: April 5, 2000 Art Unit: 2161
Serial No.: 09/543,049 Examiner: J. Hayes
Title: AUTOMATED ALTERNATIVE DISPUTE RESOLUTION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Brenda Pomerance	Confirmation:	7218
Filed:	April 5, 2000	Art Unit:	3621
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SECOND SUBSTITUTE APPEAL BRIEF

Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Board:

This Second Substitute Appeal Brief is timely filed in response to the Notification of Non-Compliant Appeal Brief, mailed September 19, 2006 and having a one-month response period.

(1) REAL PARTY IN INTEREST

The party in interest is Brenda Pomerance.

(2) RELATED APPEALS AND INTERFERENCES

In application serial no. 09/793,687, which claims priority from the instant application, a Decision was mailed on August 31, 2006, Appeal No. 2006-1523, and is included in Appendix 3.

(3) STATUS OF CLAIMS

Claims 46-63 and 82-89 are pending in this application.

Claims 82-84 have been allowed.

Un-allowed claims 46-63 and 85-89 are being appealed. Claims 46, 55 and 85 are independent, and have respective dependent claims 47-54, 56-63 and 86-89.

(4) STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

An overview is presented, and then each of the independent claims are discussed separately.

The present invention relates to an automated assisted negotiation system that provides a structured process for a complainer and a complainee to resolve a problem (page 4, line 4). If resolution cannot be achieved with the present system, the system can forward a well-formed record of the automated proceedings to a human dispute resolver for their services (page 6, line 22 – page 7, line 2).

Advantages of an automated assisted negotiation system are that

- the system is inexpensive compared with engaging a human dispute resolution professional;
- the system enables a complainer to use its dispute resolution procedure even if the complainer is unaware of dispute resolution methodology; and
- the system serves the complainer by providing portions of the complainee's predefined information to the complainer at the times when the information is relevant to the complainer

More specifically, the assisted negotiation system can be implemented as a web site interacting with a visiting complainer (page 5, lines 22-23). The system provides a complaint form to the complainer enabling the complainer to provide pertinent information about the complainer and the problem (page 7, line 11).

After the complainer enters information about the type of problem (page 7, line 15 - page 8, line 16), the system determines which portion of information previously supplied by the complainee is relevant, and supplies the relevant information to the complainer (page 9, line 22 – page 10, line 2; page 10, lines 18-21). This is substantially more convenient than the typical frequently asked questions (FAQ) approach, which requires that the complainer (a) guess that there is relevant information on the website, and (b) try to find the relevant information.

The assisted negotiation system encourages the complainer to vent their emotions, which is an important feature of dispute resolution, and prepares a summary of the emotional information for inclusion in the complaint summary (page 6, lines 7-8). Humans are built to react emotionally before they react intellectually; accordingly, it is well-known among dispute resolution professionals that giving parties an opportunity to express their feelings promotes reaching agreement, i.e., resolving the dispute. It is also well-known among dispute resolution professionals that a person who has an opportunity to be heard is more likely to be satisfied with a dispute resolution process, even if the outcome is adverse to the person. Thus, even if the

system does not make decisions based on the emotional information provided by the complainer, the mere collection of the information and “reflecting back” of the information in summary form has a positive effect on the complainer, i.e., makes the complainer “feel heard”.

The assisted negotiation system also suggests at least one remedy to the complainer, based on the nature of the complainer’s problem (page 10, lines 5-6). The at least one remedy is selected from a set of predefined remedies. Each complainee may provide its own set of acceptable remedies for various types of problems (page 10, lines 19-21). The system includes the remedy(s) chosen by the complainer in the prepared complaint summary (page 10, lines 8-9).

After the complainer approves the prepared complaint, including the actual name of the complainer (page 7, lines 15-16), the system forwards the prepared complaint to the complainee (page 10, lines 11-12).

The following charts explain how independent claims 46, 55 and 85 read on the disclosure of the present application.

46 . A method of processing a complaint, comprising:	
automatically receiving, at a computer, initial information from a complainer including information identifying the complainer,	System 60 receives initial information is received from a complainer including information identifying the complainer (page 7, line 13 – page 8, line 21: the complaint form solicits information from the complainer; Fig. 3A, step 205).
automatically selecting, at the computer, selected data from data previously received from a complainee based on the initial information from the complainer,	System 60 selects from data previously received from a complainee based on the initial information from the complainer (page 10, lines 18-21: during a setup phase, a merchant provides information to be sent to customers when a particular type of dispute occurs; page 9, line 22 – page 10, line 2: previously provided portions of a merchant’s policy are given to a customer, based on the information

	in the complaint form).
automatically providing, from the computer, the selected data to the complainer,	The selected data is provided to the complainer (page 9, line 22 – page 10, line 2: previously provided portions of a merchant's policy are given to a customer, based on the information in the complaint form).
automatically receiving, at the computer, additional information from the complainer after providing the selected data to the complainer,	Additional information is received from the complainer (page 9, lines 6-7: system 60 checks whether there is sufficient information to state a problem and at least one desired remedy; it is implicit that if there is insufficient information, the complainer must provide additional information to satisfy the need for sufficient information; page 10, lines 3-4: system 60 suggests a resolution; it is implicit that the complainer either accepts or rejects the resolution suggested by system 60).
automatically preparing, at the computer, the complaint based on the initial information and the additional information received from the complainer,	System 60 prepares the complaint based on the initial information and the additional information (page 9, lines 8-10).
automatically presenting, from the computer, the prepared complaint to the complainer for approval to generate an approved complaint, and	System 60 presents the complaint to the complainer for approval to generate an approved complaint (page 10, lines 11-15).
automatically forwarding, from the computer, the approved complaint, including the information identifying the complainer, to the complainee.	System 60 forwards the approved complaint, including the information identifying the complainer to the merchant (page 10, lines 11-12; Fig. 3A, step 210).

55. A method of processing a complaint, comprising:	
automatically receiving, at a computer, information from a complainer including information describing a problem, information relating to an emotional state of the complainer, and information identifying the complainer,	System 60 receives information from a complainer including information describing a problem (page 8, lines 5-9: menu of problems and free-form text entry describing problem), information relating to an emotional state of the complainer (page 8, lines 8-9, 10, 13: three places for free-form text entry), and information identifying the complainer (page 7, lines 15-16).
automatically, at the computer, preparing the complaint including emotional state information based on the information received from the complainer,	The complaint is automatically prepared including emotional state information based on the information received from the complainer (page 6, line 8: system 60 summarizes the complaint to filter emotional venting – implicitly, the venting that occurred in the free-form text entry; page 9, lines 8-10: system 60 prepares a complaint summary),
automatically, at the computer, presenting the prepared complaint to the complainer for approval to generate an approved complaint, and	System 60 presents its prepared complaint to the complainer for approval to generate an approved complaint (page 10, lines 11-15: the customer approves the complaint summary prepared by system 60).
automatically forwarding, from the computer, the approved complaint to the complainee.	System 60 forwards the complaint summary to the merchant (page 10, lines 11-12; Fig. 3A, step 210).

85. A method of processing a complaint, comprising:	
automatically receiving, at a computer, information from a complainer including information relating to a problem experienced by the complainer and information identifying the complainer,	System 60 receives information from a complainer including information relating to a problem experienced by the complainer (page 8, lines 5-9: menu of problems and free-form text entry describing problem) and information identifying the complainer (page 7, lines 15-16).
automatically suggesting, at the computer, at least one remedy to the complainer,	System 60 suggests a dispute resolution in addition to or instead of the remedies indicated by the complainer (page 10, lines 3-4).
automatically receiving, at the computer, a response to the at least one suggested remedy,	System 60 receives a response to the at least one suggested remedy (it is implicit that the complainer responds by accepting or rejecting the resolution suggested by system 60).
automatically preparing, at the computer, the complaint based on the information and the response received from the complainer,	System 60 prepares the complaint based on the information and the response received from the complainer (page 10, lines 11-15: the customer approves the complaint summary prepared by system 60).
automatically presenting, from the computer, the prepared complaint to the complainer for approval to generate an approved complaint, and	System 60 presents its prepared complaint to the complainer for approval to generate an approved complaint (page 10, lines 11-15: the customer approves the complaint summary prepared by system 60).
automatically forwarding, from the computer, the approved complaint to the complainee.	System 60 forwards the complaint summary to the merchant (page 10, lines 11-12; Fig. 3A, step 210).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

These issues correspond to the rejections in the Office Action of March 31, 2004.

1. Are claims 46, 48, 50, 52, 54 unpatentable over U.S. Patent No. 5,895,450 (Sloo) in view of the Online Resolution Press Release dated March 23, 2000 (“Online Resolution”)? (see paragraph 11 of the March 31, 2004 Office Action)
2. Are claims 47, 55-58, 61-63 unpatentable over Sloo in view of Online Resolution and the article by Joel Eisen, “Are We Ready for Mediation in Cyberspace” (“Eisen”)? (see paragraph 12 of the March 31, 2004 Office Action)
3. Is claim 49 unpatentable over Sloo in view of Online Resolution, Eisen and the Eileen Brownwell article “Say It Right” (“Brownwell”)? (see paragraph 13 of the March 31, 2004 Office Action)
4. Is claim 51 unpatentable over Sloo in view of Online Resolution, Eisen and U.S. Patent No. 6,154,753 (McFarland)? (see paragraph 14 of the March 31, 2004 Office Action)
5. Is claim 59 unpatentable over Sloo in view of Online Resolution, Eisen and Brownwell? (see paragraph 15 of the March 31, 2004 Office Action)
6. Is claim 60 unpatentable over Sloo in view of Online Resolution, Eisen and McFarland? (see paragraph 16 of the March 31, 2004 Office Action)
7. Are claims 85, 88, 89 unpatentable over Sloo in view of U.S. Patent No. 5,495,412 (Thiessen)? (see paragraph 17 of the March 31, 2004 Office Action)
8. Is claim 86 unpatentable over Sloo, Thiessen and Eisen? (see paragraph 18 of the March 31, 2004 Office Action)
9. Is claim 87 unpatentable over Sloo, Thiessen and McFarland? (see paragraph 19 of the March 31, 2004 Office Action)

(7) ARGUMENT

SUMMARY OF ARGUMENT

The Examiner has fallen “victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 200 USPQ 303, 312-13 (Fed. Cir. 1983).

A dispute resolution professional of ordinary skill in the art at the time the invention was made, such as an arbitrator or mediator, believed that mediation was an art using techniques

different than the techniques of arbitration, and due to this difference, would not combine techniques from arbitration with techniques from mediation (*Declaration of Kallas, para. 8-11; Declaration of Femenia, para. 9-12*). However, the Examiner improperly combined references directed to arbitration with those directed to mediation to arrive at the instant invention, redesigned what the references taught to arrive at the instant invention, and acted against the teachings of the references themselves to cherrypick them to arrive at the present invention.

Issue 1: Are claims 46, 48, 50, 52, 54 unpatentable over Sloo in view of Online Resolution?

Claim 46 relates to a method of processing a complaint by a computer. Initial information is received from a complainer including information identifying the complainer. Selected data is chosen from data previously received from a complainee based on the initial information from the complainer, and the selected data is provided to the complainer. Additional information is received from the complainer. The complaint is prepared based on the initial information and the additional information, and presented to the complainer for approval to generate an approved complaint. The approved complaint, including the information identifying the complainer, is forwarded to the complainee.

Sloo

Sloo discloses a system for handling complaints that informs other consumers about the complaints (column 1, line 23) and rewards good conduct while punishing bad conduct in complaint resolution (column 1, lines 44-50).

Sloo's system prompts a complainer to enter a detailed complaint including identifying information – the user's phone number and e-mail address – keywords summarizing the complaint, and a requested remedy (column 4, lines 49-52; column 4, line 63 – column 5, line 2). The identifying information is used to track the complainer's conduct (column 5, lines 3-6). The system sends the complaint to the complainer by e-mail, receives a confirmation including any corrections and, as verification, compares the confirmation to the detailed complaint (column 5, lines 20-29).

The system creates a unique e-mail address for the complainer, to be used by the complainer and complainee so they can privately negotiate a settlement by communicating directly with each other (column 5, lines 11-19; column 7, lines 33-35 and 42-65).

Then, Sloo's system sends to the complainee the detailed complaint, the suggested remedy and the complainer's unique e-mail address (column 5, lines 38-45). Sloo's system does not disclose the name of the complainer to the complainee; the anonymity encourages complaint filing (column 6, lines 43-46).

If direct negotiation between the complainer and the complainee does not yield a resolution, the complaint can be referred to a jury (column 8, lines 5-45) or to a computer program that decides the complaint (column 9, line 57 – column 10, line 14).

Sloo's system posts a notice of the complaint in a public database including the keywords or abbreviated description of the complaint entered by the user (column 5, lines 3-6). The public database is searchable by the public (column 5, lines 57-65)

Sloo states, at column 6, lines 42-46,

Additionally, the apparatus 10 does not disclose the actual names of the complainants to the subjects [complainees] so that the complainants may remain anonymous. This further encourages users to file complaints with the apparatus.

The combination of Sloo and Online Resolution

In *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir. 2000), *cert. den.* 2000 US LEXIS 4144 (2000), the Court stated,

[I]f Johnson did in fact teach away from Moore, then that finding alone can defeat Wang's obviousness claim. ... A "reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the results sought by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed Cir. 1994).

Claim 46 requires "automatically forwarding, from the computer, the approved complaint, including the information identifying the complainer, to the complainee". Sloo explicitly and plainly teaches *withholding* information identifying the complainer from the complainee; thus Sloo teaches away from the invention of claim 46. Under *Winner Int'l Royalty Corp.*, the fact that Sloo teaches away from the invention of claim 46 defeats the Examiner's obviousness assertion.

Online Resolution is directed to a system that supports a human mediator, whereas Sloo does not have a human mediator, so it is improper to combine Sloo and Online Resolution (*Declaration of Kallas, para. 10; Declaration of Femenia, para. 11*). Even if these references

had to be combined, since Sloo's anonymity is an important feature of its system, one of ordinary skill in the art of dispute resolution would not modify Sloo's system so that the complainer is named (non-anonymous) (*Declaration of Kallas, para. 14; Declaration of Femenia, para. 15*).

Thus, claim 46 is not made obvious by any proper combination of Sloo and Online Resolution. Claims 48, 50, 52 and 54, in depending from claim 46, are similarly not made obvious by the cited references.

For the reasons discussed above, claims 46, 48, 50, 52, 54 are patentable over any proper combination of Sloo and Online Resolution.

The Examiner's Answer, mailed February 15, 2005, states at page 4,

Although Sloo teaches that the communications between the complainer and complainee are anonymous, examiner submits that it would have been obvious ... to provide complainer identifying information to the complainee in the event that the parties have no desire to remain anonymous.

Applicant disagrees. The whole point of Sloo is that complainers can publicly post complaints without fear of retribution. Sloo carefully provides a private e-mail address mechanism which preserves the anonymity of the complainer. If a complainer wishes to be known to the complainee, the complainer must deliberately disclose his or her identity. It is improper for the Examiner, lacking explicit motivation in the prior art, to redesign Sloo to eliminate the anonymity that Sloo has so carefully incorporated.

Issue 2: Are claims 47, 55-58, 61-63 unpatentable over Sloo in view of Online Resolution and Eisen?

The claims of the group corresponding to Issue 2 above do not stand or fall together, as this group encompasses claims depending from two independent claims. Arguments are presented below as to why claims subject to the same rejection are separately patentable. Issue 2 above is considered as Issues 2A and 2B:

- 2A. Is claim 47 unpatentable over Sloo, Online Resolution and Eisen? (see paragraph 12 of the March 31, 2004 Office Action)
- 2B. Are claims 55-58, 61-63 unpatentable over Sloo, Online Resolution and Eisen? (see paragraph 12 of the March 31, 2004 Office Action)

Issue 2A: Is claim 47 unpatentable over Sloo, Online Resolution and Eisen?

Eisen

Eisen discloses online mediation via e-mail that passes through a human mediator (page 2, last paragraph; page 3, first and second paragraphs) with documents posted on a website (page 2, second paragraph). Eisen argues that such online mediation is unfeasible until technology progresses to replicate face-to-face interactions (page 1, abstract; page 2, third paragraph; page 15, second paragraph).

Eisen points out that the written nature of online mediation will create communication breakdowns (page 2, first paragraph).

Eisen notes that the anonymity of the Internet is a main attraction, but that this anonymity creates an authentication problem (page 7, second paragraph).

Eisen does not justify redesigning Sloo to be non-anonymous, as incorporated in claim 47 by virtue of its dependence from claim 46. Accordingly, claim 47 is patentable over any proper combination of Sloo, Online Resolution and Eisen.

Issue 2B: Are claims 55-58, 61-63 unpatentable over Sloo, Online Resolution and Eisen?

Claim 55 relates to a method of processing a complaint by a computer. Information is received from a complainer including information describing a problem, information relating to an emotional state of the complainer, and information identifying the complainer. The complaint is automatically prepared including emotional state information based on the information received from the complainer, and presented to the complainer for approval to generate an approved complaint. The approved complaint is automatically forwarded to the complainee.

Online Resolution

Online Resolution discloses a way for mediators to use the Internet for mediating disputes between people who will never meet (page 2, paragraph 1).

A complainer goes to a web site, fills out a form describing their complaint and submits the complaint by e-mail to the Mediation Information and Resource Center (MIRC). MIRC contacts the complainee, and if the complainee agrees to mediation, MIRC selects a human mediator. The complainer, complainee and human mediator then communicate by e-mail to solve the problem (page 1, last paragraph). Fees range from \$50 to \$100 per hour of mediator time (page 1, penultimate paragraph).

If in-person negotiation is desired, MIRC will provide names of mediators in the geographic area of the complainer and complainee (page 2, fourth paragraph).

Online Resolution quotes John Helie and Colin Rule. With regard to online mediation, Helie states (page 2, second paragraph),

Yes, you don't have the nonverbal cues, but the face-to-face in most cases is overrated and not necessary.

Rule states that just as body language matters in negotiation, politeness matters in e-mail mediations (page 2, sixth paragraph), and notes (page 2, seventh paragraph),

Emotions are a big part of the mediation process.

Eisen

Eisen is consistently skeptical about the efficacy of online mediation due to the constraints of an online process:

One's ability to express emotion online is different; cyberspace currently "comes without all five senses attached." Oral expressions of feelings in a face-to-face setting have a richer and more meaningful context than written expressions of feelings in an E-mail exchange. (page 2, last paragraph)

The substitution of E-mail for dialogue, for example, makes it difficult to give any weight to emotion in mediation. (page 5, second paragraph)

The opportunity to tell one's version of the case directly to the opposing party and to express accompanying emotions can be cathartic for mediation participants. ... I am extremely doubtful that catharsis could happen in any setting other than a face-to-face conversation. (page 5, second-third paragraph)

The emotional impact of articulating one's position is attenuated if one is separated from the listener by an electronic distance. If an element of the catharsis is not simply to tell one's story, but also to have an effect on the listener, then online mediation seems hampered as well by the limitations on one's ability to emote online. (page 5, third paragraph)

Sending E-mail is a solitary endeavor, bereft of the opportunity to engage the parties in a therapeutic conversation and to listen to and understand their concerns, emotions and feelings. **To the extent that this is an important value of the mediation**

process, online mediation could not accomplish it.
(page 5, fourth paragraph, emphasis added)

The claims about the benefits of electronic distance amount to blatant double-talk. ... using E-mail isolates the participants from one another. (page 6, first paragraph)

Moreover, in making the assumption that introspection may be desirable, proponents are inappropriately considering "thoughtful" reflections to be more valuable than instinctive articulations of emotion or anger. Removing the ability to articulate in the moment might prevent participants from making spontaneous proposals about issues in dispute, and would disadvantage those participants who are not introspective. (page 6, last paragraph)

[I]t would be an unwarranted arrogation of decision-making authority if an online mediator deliberately suppressed expressions of anger or emotion in order to promote "constructive" responses. (sentence bridging pages 6-7)

Like a listserv moderator, the mediator would believe it to be her responsibility to filter out messages that would tend to derail the proceeding, such as messages expressing anger, emotion, or bias. (page 14, first paragraph)

Eisen notes that online mediation could be very costly due to consuming computer resources, higher costs of researching and articulating one's position in textual form, and more mediator time needed to review submissions in their entirety (page 10, first paragraph).

The combination of Sloo, Online Resolution and Eisen

As the Examiner acknowledged, Sloo does not show or suggest collecting emotional information during complaint preparation.

Each of Online Resolution and Eisen is concerned with mediation involving a human mediator. It is improper to combine Sloo, relating to an arbitration system, with either of Online Resolution or Eisen, since these references relate to mediation (*Declaration of Kallas, para. 10 and 11; Declaration of Femenia, para. 11 and 12*).

Even if Sloo, Online Resolution and Eisen were combined, the result would be to modify Sloo's direct negotiation to be an online mediation with a human mediator addressing the emotional states of the disputants (*Declaration of Kallas, para. 12 and 13; Declaration of Femenia, para. 13 and 14*).

The Eisen reference does not teach collecting emotional state information in a system lacking a mediator. The Eisen reference teaches that emotions are an important part of the mediation process, that emotions cannot be properly conveyed in e-mail, and so online mediation will not live up to its promotions. To be usable for what it teaches away from, Eisen would have to present the teaching for the same use as in the claimed invention, which Eisen does not do. Accordingly, the Examiner's combination of Eisen and Sloo was improper.

Similarly, Online Resolution does not teach a computer that collects emotional state information; instead, Online Resolution is concerned with a human mediator that uses a computer as a communication means. Online Resolution's business was to sell the services of human mediators at a fairly hefty hourly fee; there is no suggestion in Online Resolution of eliminating human mediators. Accordingly, the Examiner's combination of Online Resolution and Sloo was improper.

In short, there is no proper combination of the cited references, and even if they are combined, since each of them lacks the feature of "receiving, at a computer, information relating to an emotional state of the complainer", the combination of the cited references does not render claim 55 obvious.

Claims 56-58 and 61-63, in depending from claim 55, incorporate all of its features and are not made obvious by the cited references for the reasons discussed above.

Thus, claims 55-58, 61-63 are patentable over Sloo, Online Resolution and Eisen.

Issue 3: Is claim 49 unpatentable over Sloo in view of Online Resolution, Eisen and Brownwell?

Brownwell

Brownwell was cited for its disclosure of the use of first person language. Brownwell is an article on effective interpersonal communication.

Brownwell does not justify redesigning Sloo to be non-anonymous, as incorporated in claim 49 by virtue of its dependence from claim 46. Accordingly, claim 49 is patentable over any proper combination of Sloo, Online Resolution, Eisen and Brownwell.

Issue 4: Is claim 51 unpatentable over Sloo in view of Online Resolution, Eisen and McFarland?

McFarland

McFarland was cited as teaching a method for entering customer complaints into its system, wherein the complaint form is saved with an indication of when follow up with the customer is needed. McFarland relates to a quality standards document control system.

McFarland does not justify redesigning Sloo to be non-anonymous, as incorporated in claim 51 by virtue of its dependence from claim 46. Accordingly, claim 51 is patentable over any proper combination of Sloo, Online Resolution, Eisen and McFarland.

Issue 5: Is claim 59 unpatentable over Sloo in view of Online Resolution, Eisen and Brownwell?

Brownwell does not show or suggest the feature of “receiving, at a computer, information relating to an emotional state of the complainer” incorporated in claim 59 by virtue of its dependence from claim 55, and, as discussed above, this feature is also absent from Sloo, Online Resolution and Eisen, so the combination of the cited references does not render claim 59 obvious.

For the reasons discussed above, claim 59 is patentable over Sloo, Online Resolution, Eisen and Brownwell.

Issue 6: Is claim 60 unpatentable over Sloo in view of Online Resolution, Eisen and McFarland?

McFarland does not show or suggest the feature of “receiving, at a computer, information relating to an emotional state of the complainer” incorporated in claim 60 by virtue of its dependence from claim 55, and, as discussed above, this feature is also absent from Sloo, Online Resolution and Eisen, so the combination of the cited references does not render claim 60 obvious.

For the reasons discussed above, claim 60 is patentable over any proper combination of Sloo, Online Resolution, Eisen and McFarland.

Issue 7: Are claims 85, 88, 89 unpatentable over Sloo in view of Thiessen?

Claim 85 relates to a method of processing a complaint by a computer. Information is received from a complainer including information relating to a problem experienced by the complainer and information identifying the complainer. At least one remedy is automatically suggested to the complainer by the computer. A response to the at least one suggested remedy is received. The complaint is prepared based on the information and the response received from the complainer, and the prepared complaint is presented to the complainer for approval to generate an approved complaint. The approved complaint is forwarded to the complainee.

Thiessen

Thiessen discloses a system that assists multi-party negotiations (column 3, lines 11-15). A set of issues is defined and agreed upon by the parties (column 6, lines 2-15). Then each party inputs its preferences – a range of decision values -- on the issues to confidential system files (column 6, lines 16-30). Based on the preferences, Thiessen’s system uses a linear programming algorithm to propose alternative solutions to the parties (column 8, lines 46-49). The system is useful because it has confidential information (column 12, line 55 – column 12, line 2).

The combination of Sloo and Thiessen

Sloo does not disclose suggesting a remedy to a complainer during complaint preparation, as specifically recited in claim 85. To one of ordinary skill in the art of dispute resolution, changing Sloo so that the computer suggests a remedy to the complainer during complaint filing would change Sloo’s fundamental dynamics and create a system substantively different than Sloo’s system (*Declaration of Kallas, para. 15; Declaration of Femenia, para. 16*).

While Thiessen discloses proposing alternative solutions, its alternative solutions are based on preferences input by parties. Thiessen’s system functions as an elaborate calculator. Thiessen assumes that the parties are negotiating directly with each other, such as to agree on what the issues are. Thiessen is not concerned with automating the negotiation process.

There is no reason that one of ordinary skill in the art would combine Sloo and Thiessen, other than improperly using claim 85 as a guide for hindsight reconstruction.

Even if Thiessen and Sloo were combined, to one of ordinary skill in the art, adding Thiessen’s system to Sloo would merely give the complainant the ability to rank his or her preferences; the feature of suggesting a solution would not occur because the target of the

complaint is not a user of Sloo's system. Thus, in the reasonable combination of Thiessen and Sloo, the complaint would be posted without a suggested solution.

Applicant recognizes that Sloo later provides the ability for the target of the complaint and the complainer to exchange anonymous email, but even if the target was amenable to providing its preferences, and thus a solution could be suggested, this is still *after* the complaint was posted in Sloo's system, and thus is not the subject matter of claim 85.

That is, there is no proper combination of Sloo and Thiessen that renders claim 85 obvious.

Claims 88 and 89, in depending from claim 85, are similarly not obvious over any proper combination of Sloo and Thiessen.

For the reasons discussed above, claims 85, 88, 89 are patentable over any proper combination of Sloo and Thiessen.

The Examiner's Answer, mailed February 15, 2005, states at page 13,

Thiessen provides motivation [to modify Sloo] by indicating that making suggestions or proposed solutions would provide an alternative that all parties of a conflict could consider and might find acceptable

However, even if Thiessen does suggest the desirability of proposing solutions, it does so only when the parties to the conflict are participating in resolution. In Sloo, this co-operation between the parties only occurs *after* the complaint is filed. Thus, the Examiner has not made a proper obviousness rejection, since claim 85 requires automated solution suggesting *prior to* the filing of the complaint.

Issue 8: Is claim 86 unpatentable over Sloo, Thiessen and Eisen?

Eisen does not justify fundamentally altering Sloo so that Sloo's system suggests a remedy to the complainer during complaint preparation, as incorporated in claim 86 by virtue of its dependence from claim 85. As discussed above, each of Thiessen and Sloo fails to show or suggest suggesting a remedy to the complainer *during* complaint preparation. Thus, there is no proper combination of the cited references that makes claim 86 obvious.

For the reasons discussed above, claim 86 is patentable over any proper combination of Sloo, Thiessen and Eisen.

Issue 9: Is claim 87 unpatentable over Sloo, Thiessen and McFarland?

McFarland does not justify fundamentally altering Sloo so that Sloo's system suggests a remedy to the complainer during complaint preparation, as incorporated in claim 87 by virtue of its dependence from claim 85. As discussed above, there is no proper combination of Sloo and Thiessen that suggests a remedy to the complainer during complaint preparation. Thus, there is no proper combination of the cited references that makes claim 87 obvious.

For the reasons discussed above, claim 87 is patentable over any proper combination of Sloo, Thiessen and McFarland.

(8) CLAIMS APPENDIX

Appendix 1 contains a copy of the pending claims.

(9) EVIDENCE APPENDIX

Copies of *Declaration of Kallas* and *Declaration of Femenia*, were filed on February 17, 2004, were included with the Substitute Appeal Brief filed on November 14, 2005, and are filed herewith as Appendices 2A and 2B.

(10) RELATED PROCEEDINGS APPENDIX

The decisions rendered by the Board of Patent Appeals in the proceeding identified pursuant to section (2) of this Brief is provided as Appendix 3 hereof.

For the reasons discussed above, applicant requests that the Board of Appeals reverse the Examiner's rejections of claims 46-63 and 85-89.

Respectfully submitted,

Date: October 19, 2006

Brenda Pomerance
Brenda Pomerance

Address:

Law Office of Brenda Pomerance
260 West 52 St. Ste. 27B
New York, NY 10019
voice 212 245-3940

APPENDIX 1. CLAIMS APPENDIX

Claims 1-45 are cancelled.

46. A method of processing a complaint, comprising:
 - automatically receiving, at a computer, initial information from a complainer including information identifying the complainer,
 - automatically selecting, at the computer, selected data from data previously received from a complainee based on the initial information from the complainer,
 - automatically providing, from the computer, the selected data to the complainer,
 - automatically receiving, at the computer, additional information from the complainer after providing the selected data to the complainer,
 - automatically preparing, at the computer, the complaint based on the initial information and the additional information received from the complainer,
 - automatically presenting, from the computer, the prepared complaint to the complainer for approval to generate an approved complaint, and
 - automatically forwarding, from the computer, the approved complaint, including the information identifying the complainer, to the complainee.

47 . The method of claim 46, wherein the prepared complaint includes emotional state information relating to the complainer.

48 . The method of claim 46, wherein the prepared complaint includes indications of at least two remedies desired by the complainer.

49 . The method of claim 46, wherein the prepared complaint includes statements in first person language based on information received from the complainer that was not in first person language.

50 . The method of claim 46, wherein the data previously received from the complainee relates to the complainee's complaint handling policy.

51 . The method of claim 46, further comprising docketing the approved complaint for predetermined actions at predetermined times.

52 . The method of claim 46, further comprising providing a response from the complainee to the complainer.

53 . The method of claim 52, further comprising automatically preparing a case summary based on the complaint and the response.

54 . The method of claim 46, further comprising providing data relating to other complaints to the complainer prior to preparing the complaint.

55. A method of processing a complaint, comprising:
automatically receiving, at a computer, information from a complainer including information describing a problem, information relating to an emotional state of the complainer, and information identifying the complainer,
automatically, at the computer, preparing the complaint including emotional state information based on the information received from the complainer,
automatically, at the computer, presenting the prepared complaint to the complainer for approval to generate an approved complaint, and
automatically forwarding, from the computer, the approved complaint to the complainee.

56 . The method of claim 55, further comprising providing data previously received from the complainee to the complainer prior to preparing the complaint.

57 . The method of claim 56, wherein the data previously received from the complainee relates to the complainee's complaint handling policy.

58 . The method of claim 55, wherein the prepared complaint includes indications of at least two remedies desired by the complainer.

59 . The method of claim 55, wherein the prepared complaint includes statements in first person language based on information received from the complainer that was not in first person language.

60 . The method of claim 55, further comprising docketing the approved complaint for predetermined actions at predetermined times.

61 . The method of claim 55, further comprising providing a response from the complainee to the complainer.

62 . The method of claim 61, further comprising automatically preparing a case summary based on the complaint and the response.

63 . The method of claim 55, further comprising providing data relating to other complaints to the complainer prior to preparing the complaint.

Claims 64-81 are cancelled.

82. A method of processing a complaint, comprising:
- automatically forwarding, from a computer, a complaint approved by the complainer to a first complainee,
- automatically detecting, at the computer, that the first complainee caused the complaint to be forwarded to a second complainee,
- automatically detecting, at the computer, that the second complainee indicated that the complaint should be forwarded to the first complainee, and
- automatically initiating, at the computer, a procedure to determine which of the first complainee and second complainee is responsible for substantively responding to the complaint.

83. The method of claim 82, wherein the procedure includes sending a notice to the first and second complainees requesting that they determine which of them is responsible for substantively responding to the complaint.

84. The method of claim 82, wherein the procedure includes automatically selecting one of the first and second complainees to substantively respond to the complaint.

85. A method of processing a complaint, comprising:
- automatically receiving, at a computer, information from a complainer including information relating to a problem experienced by the complainer and information identifying the complainer,
- automatically suggesting, at the computer, at least one remedy to the complainer,
- automatically receiving, at the computer, a response to the at least one suggested remedy,
- automatically preparing, at the computer, the complaint based on the information and the response received from the complainer,
- automatically presenting, from the computer, the prepared complaint to the complainer for approval to generate an approved complaint, and
- automatically forwarding, from the computer, the approved complaint to the complainee.
86. The method of claim 85, wherein the prepared complaint includes emotional state information relating to the complainer.
87. The method of claim 85, further comprising docketing the approved complaint for predetermined actions at predetermined times.

88 . The method of claim 85, further comprising providing a response from the complainee to the complainer.

89 . The method of claim 85, further comprising providing data relating to other complaints to the complainer prior to preparing the complaint.

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BRENDA 5

APPENDIX 2A. DECLARATION OF FEMENIA

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Brenda Pomerance	Confirmation:	7218
Filed:	April 5, 2000	Art Unit:	3261
Serial No.:	09/543,049	Examiner:	J. Hayes
Title:	AUTOMATED ALTERNATIVE DISPUTE RESOLUTION		

DECLARATION OF NORA FEMENIA

1. Since August 2002, I have been an Associate Professor of Conflict Resolution at the School for International Training, Kipling Road, P.O. Box 676, Brattleboro, VT 05302. From 1996-2000, I was an Assistant Professor, Department of Dispute Resolution, Nova Southeastern University, Fort Lauderdale, FL 33314. In 1997, I founded and became President of Inter-mediacion, Inc., Fort Lauderdale, FL, a company that provides research, training and consulting in the area of organizational conflicts; about 600 professionals, including lawyers, have paid to be trained by Inter-mediacion, Inc.
2. I am an arbitrator for the National Association of Securities Dealers (NASD), and in that capacity, I have served as a public arbitrator in about 12 arbitration procedures, and as the chair person of the arbitration tribunal in four arbitrations. I have been sole arbitrator in three arbitrations. I have served as a mediator in about 120 mediations. In 1993, I received a Ph.D. from Syracuse University, Maxwell School of Citizenship and Public Affairs, Program on Analysis and Resolution of Conflicts. I am skilled in the art of dispute resolution.
3. I have reviewed the following:
 - a. U.S. Patent No. 5,895,450 (Sloo),
 - b. the Online Resolution Press Release dated March 23, 2000, "Online Mediation Offered for Resolving E-Commerce Disputes" (OM), and
 - c. Eisen, Joel B., "Are we ready for mediation in cyberspace", Brigham Young Univ. Law Review, vol. 1998, no. 4, pp 1305-1358, 1998 (Eisen)
4. Sloo discloses a computer system that collects a complaint from a complainer (col. 4, lines 45 – col. 5, line 2) and delivers it anonymously to a target company (col. 6, lines 43-46). The complainer and target company can directly negotiate via email (col. 7, line 42

– col. 8, line 4), with the complainer remaining anonymous (col. 5, lines 12-19). The complainer can request that the complaint be decided by a third party (col. 8, lines 5-49) or the computer system (col. 9, line 57 – col. 10, line 14). Sloo’s system collects information about who the complainer is merely to prevent wrongful use of the complaint system (col. 4, lines 55-60). In short, Sloo’s computer system collects a complaint from a complainer, enables anonymous direct negotiation and allows the complainer to request arbitration of the complaint.

5. OM is directed to an online mediation system wherein a complainer fills out a form and emails it to the Mediation Information and Resource Center’s website. The Center contacts the other party, and if the other party agrees to mediation, the Center selects a human mediator who conducts a mediation between the parties using email, instant messaging and group discussions, at a rate of \$50-100 per hour (paragraph bridging pages 1-2).
6. I first met John Helie, quoted in OM, in 1997. At professional conferences, Mr. Helie has stated his belief that an online system will help channel emotions out of mediation, since a computer is unaware of emotions. Mr. Helie has urged an online system that manages processing of factual information, to eliminate emotions from mediation.
7. Eisen argues that an online setting, in which all email is assumed to pass through a human mediator, is not suitable for mediation as it hampers mediators’ face-to-face skills such as listening and processing oral information (page 1, bottom; page 3, second paragraph).
8. While arbitration and mediation are both techniques for dispute resolution, the role of an arbitrator is quite different than the role of a mediator. Arbitration and mediation differ in the amount of control left in participants’ hands, retaining self-determination in mediation, while relying on the arbitrator’s decision in arbitration. For example:
 - a. an arbitrator must not have private discussions with any of the parties to the dispute, whereas a mediator routinely has private meetings with each of the parties;
 - b. an arbitrator’s purpose is to provide a decision that resolves the dispute, whereas a mediator’s purpose is to help the parties craft their own solution;

- c. an arbitrator ends the arbitration by providing a decision, whereas a mediator can end a mediation with the dispute remaining unresolved;
 - d. arbitration is generally binding, whereas mediation is not; and mediation can be convened as many times as necessary according to parties' need;
 - e. if a party serves as mediator to a dispute, the party should decline to serve as arbitrator as a matter of professional responsibility, unless the parties agreed in advance to use "med-arb"
9. One of ordinary skill in the art of mediation considers mediation to be an art, with mediators conducting mediations according to their own personal styles.
10. One of ordinary skill in the art of arbitration considers arbitration to be akin to an adversarial court judgment but with less formal evidentiary rules and hopefully faster than a court action.
11. One of ordinary skill in the art of dispute resolution would not combine Sloo and OM. Since mediation techniques are so different than arbitration techniques, one of ordinary skill in the art would not try to combine the teachings of OM, relating to mediation, with those of Sloo, relating to arbitration. To a dispute resolver of ordinary skill, either the parties wish to retain decision control or wish to have a third party make a decision, and this determines which of mediation or arbitration will occur.
12. One of ordinary skill in the art of dispute resolution would not combine Sloo and Eisen. Since mediation techniques are so different than arbitration techniques, one of ordinary skill in the art would not try to combine the teachings of Eisen, relating to mediation, with those of Sloo, relating to arbitration.
13. Even if Sloo and OM could be combined, the resulting combination would not include a computer system that collects the emotional state of a complainer. If Sloo and OM had to be combined, a dispute resolver having ordinary skill in the art of dispute resolution would either:
- a. modify Sloo's email direct negotiation to be an online mediation in which the mediator manages the emotional status of the parties using his or her own personal techniques, or

- b. create a procedure similar to “med-arb” where the dispute resolver deals with parties’ needs, but renders an impartial decision; in the case of med-arb, the disputants’ emotional state becomes irrelevant.
14. Even if Sloo and Eisen could be combined, the resulting combination would not include a computer system that collects the emotional state of a complainer. If Sloo and Eisen had to be combined, a dispute resolver having ordinary skill in the art of dispute resolution would either:
- a. modify Sloo’s email direct negotiation to be an online mediation in which the mediator manages the emotional status of the parties using his or her own personal techniques, or
 - b. create a procedure similar to “med-arb” where the dispute resolver deals with parties’ needs, but renders an impartial decision; in the case of med-arb, the disputants’ emotional state becomes irrelevant.
15. One of ordinary skill in the art of dispute resolution would not modify Sloo’s system so that the complainer is named (non-anonymous) to the target of the complaint. Protecting privacy and confidentiality is paramount in conflict resolution, so parties can freely express their complaints. For Sloo, complainer anonymity is important to overcome the problem of private complaint systems not informing other consumers about complaints (col. 1, lines 17-25). Sloo, as is, enables complainers who want to be known to the target to reveal their identity in email direct negotiation. Sloo deliberately chose to provide for anonymous complaining in contrast to the prior art, and to a dispute resolver of ordinary skill, named complaining would destroy the essence of Sloo’s system.
16. One of ordinary skill in the art of dispute resolution would not modify Sloo’s system to suggest a remedy to a complainer during filing of the complaint. Dispute resolution systems are based on the premise of parties’ self-determination and ability to find their own solutions, if given the opportunity. Sloo’s “Automated Decision Maker” enables a complainer to determine the likely computer-generated decision of a dispute before filing a complaint (col. 10, lines 48-52 and col. 11, lines 21-36), so enhancing the complainer’s possible solution choices with feedback. To one of ordinary skill in the art of dispute resolution, changing Sloo so that the computer suggests a remedy to the complainer during complaint filing would change Sloo’s fundamental dynamics from a direct

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negotiation/arbitration system to an imposed solution system. The core of a disputant's power to progress through the stages of dispute resolution involving a negotiation would be eliminated by thus changing Sloo, which fundamentally changes Sloo's system from a dispute resolution system to a solution selection system that does not respect individual decision making, and this is a key difference to a dispute resolver of ordinary skill in the art.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Title 18 of the United States Code, Section 1001, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Feb 16, 2004

Date

Nora Femenia
Nora Femenia, Ph. D.

APPENDIX 2B. DECLARATION OF KALLAS

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Brenda Pomerance	Confirmation:	7218
Filed:	April 5, 2000	Art Unit:	3261
Serial No.:	09/543,049	Examiner:	J. Hayes
Title:	AUTOMATED ALTERNATIVE DISPUTE RESOLUTION		

DECLARATION OF CHRISTINA KALLAS

1. I am an attorney in private practice, employed by Law Office of Christina Kallas, 5009 Broadway, Suite 604, New York, New York 10034.
2. I am an arbitrator for the National Association of Securities Dealers (NASD). I have served as an arbitrator in about 30 arbitrations, and as the Chair of several arbitration panels. I have served as a mediator or co-mediator in about 75 - 100 mediations. Since 1994, I have taken or given training courses in the area of arbitration, mediation and negotiation at universities, bar associations, professional societies, government agencies and regulatory agencies. I am skilled in the art of dispute resolution.
3. I have reviewed the following:
 - a. U.S. Patent No. 5,895,450 (Sloo),
 - b. the Online Resolution Press Release dated March 23, 2000, "Online Mediation Offered for Resolving E-Commerce Disputes" (OM), and
 - c. Eisen, Joel B., "Are we ready for mediation in cyberspace", Brigham Young Univ. Law Review, vol. 1998, no. 4, pp 1305-1358, 1998 (Eisen)
4. Sloo discloses a computer system that collects a complaint from a complainer (col. 4, lines 45 – col. 5, line 2) and delivers it anonymously to a target company (col. 6, lines 43-46). The complainer and target company can directly negotiate via email (col. 7, line 42 – col. 8, line 4), with the complainer remaining anonymous (col. 5, lines 12-19). The complainer can request that the dispute evidenced by the complaint be decided by a third party (col. 8, lines 5-49) or the computer system (col. 9, line 57 – col. 10, line 14). Sloo's system collects information about who the complainer is in order to prevent wrongful use of the complaint system (col. 4, lines 55-60). In short, Sloo's computer system

- collects a complaint from a complainer, enables anonymous direct negotiation and allows the complainer to request arbitration of the dispute arising out of the complaint.
5. A person interested in using the OM system is directed to a website wherein a complainer fills out a form and emails it to the Mediation Information and Resource Center. The Center contacts the other party to the dispute, and if the other party agrees to mediation, the Center selects a human mediator who conducts a mediation between the parties using email, instant messaging and group discussions, at a rate of \$50-100 per hour (paragraph bridging pages 1-2).
 6. Eisen argues that an online setting, in which all email is assumed to pass through a human mediator, is not suitable for mediation as it precludes mediators from using their face-to-face skills such as listening and processing oral information (page 1, bottom; page 3, second paragraph), which are historically fundamental to the mediator's role.
 7. While arbitration and mediation are both techniques for dispute resolution, the role of an arbitrator is quite different from the role of a mediator. For example:
 - a. an arbitrator must not have private discussions with any of the parties to the dispute, whereas a mediator, as an integral part of the mediation process, may well decide to use this 'caucusing technique' as a deliberate strategy in resolving the dispute;
 - b. an arbitrator's purpose is to render a decision that resolves the dispute, whereas a mediator's purpose is to help the parties craft their own solution, regardless of the mediator's opinion as to the 'best' or 'fairest' outcome;
 - c. an arbitrator ends the arbitration by issuing a decision, whereas a mediator can end a mediation even though the dispute remains unresolved; and
 - d. if a party serves as mediator to a dispute, the party should decline to serve as arbitrator because while serving as mediator, the mediator has become privy to confidential information that may not be available to someone acting as an arbitrator.
 8. One of ordinary skill in the art of mediation considers mediation to be an art, with mediators conducting mediations according to their own personal styles, often relying upon instinct.

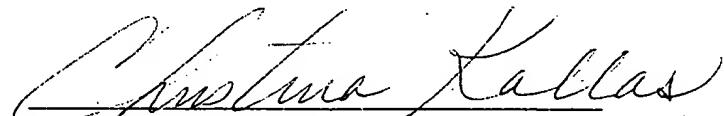
9. One of ordinary skill in the art of arbitration considers arbitration to be akin to an adversarial court judgment conducted in accordance with less formal evidentiary rules than a traditional court action and, ideally, resulting in a faster resolution than a traditional court action.
10. Since mediation techniques are so different from arbitration techniques, one of ordinary skill in the art of dispute resolution would not try to combine the teachings of OM, relating to mediation, with those of Sloo, relating to arbitration, in the same proceeding.
11. Since mediation techniques are so different from arbitration techniques, one of ordinary skill in the art would not try to combine the teachings of Eisen, relating to mediation, with those of Sloo, relating to arbitration, in the same proceeding.
12. If a dispute resolver attempted to combine the approaches of Sloo and OM , the resulting combination would not include a computer system that collects input concerning the emotional state of a complainer. If the approaches of Sloo and OM had to be combined, a dispute resolver having ordinary skill in the art of dispute resolution would modify Sloo's email direct negotiation approach to be an online mediation in which the mediator directly addresses the emotional states of both parties using his or her own personal techniques as a fundamental part of the mediation process.
13. If a dispute resolver attempted to combine the approaches of Sloo and Eisen, the resulting combination would not include a computer system that collects input concerning the emotional state of a complainer. If the approaches of Sloo and Eisen had to be combined, a dispute resolver having ordinary skill in the art of dispute resolution would modify Sloo's email direct negotiation approach to be an online mediation in which the mediator directly addresses the emotional states of both parties using his or her own personal techniques as a fundamental part of the mediation process.
14. One of ordinary skill in the art of dispute resolution would not modify Sloo's system so that the complainer is named (non-anonymous) to the target of the complaint. For Sloo, complainer anonymity is important as a means to overcome the problem of private complaint systems which do not inform other consumers about complaints against those providing services or merchandise to the public (col. 1, lines 17-25). Sloo, as is, enables complainers who want to be known to the target to reveal their identity in email direct negotiation. Sloo deliberately chose to provide for anonymous complaining in contrast to

the prior art, and to a dispute resolver of ordinary skill, naming the complainer would undermine the essence of Sloo's system, which is designed to encourage people to be honest in their complaints without fear of retribution or ridicule.

15. One of ordinary skill in the art of dispute resolution would not modify Sloo's system to suggest a remedy to a complainer during filing of the complaint. Sloo's "Automated Decision Maker" enables a complainer to determine the likely computer-generated decision of a dispute before filing a complaint (col. 10, lines 48-52 and col. 11, lines 21-36); and Sloo chose to have this be separate from the complaint filing process. To one of ordinary skill in the art of dispute resolution, changing the complaint filing process so that the computer suggests a result to the complainer during complaint filing would change Sloo's fundamental dynamics and create a system substantively different than Sloo's system.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Title 18 of the United States Code, Section 1001, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2/13/04
Date


Christina Kallas

APPENDIX 3. RELATED DECISION APPENDIX

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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

AUG 31 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRENDA POMERANCE

Appeal No. 2006-1523
Application No. 09/793,687
Technology Center 3600

ON BRIEF

Before CRAWFORD, NAPPI and FETTNG **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134(a) of the final rejection of claims 1 through 6, 8, 9, 11 and 14 through 26, claims 7, 10, 12 and 13 have been canceled. For the reasons stated *infra* we affirm in part the examiner's rejection of these claims.

Invention

The invention relates to an automated complaint resolution system. See page 3 of appellant's specification. Claim 1 is representative of the invention and reproduced below:

1. A method for automated resolution of a complaint from a complainer against a respondent, the complaint having a desired remedy, comprising:
 - comparing, at a computer, the desired remedy with business rules previously defined by the respondent to generate a comparison,
 - detecting, at the computer, lack of agreement between the complainer and the respondent based on the comparison, and
 - at the computer, performing a procedure to enable the respondent to create a first response for the complainer, and again performing the procedure to enable the complainer to create a second response for the respondent, wherein the procedure includes:
 - (a) providing at least two of historical information, advisory information and contra-party current position information to a response creator, the response creator being one of the complainer and respondent, the contra-party being the other of the complainer and respondent,
 - (b) suggesting a solution to the response creator when the response creator does not agree with a desired outcome identified in the contra-party current position,
 - (c) receiving input from the response creator in response to the suggested solution,
 - (d) preparing a draft response including at least predefined parameters based on the received input,
 - (e) displaying the draft response to the response creator,
 - (f) receiving an approval of the draft response from the response creator, and
 - (g) sending the approved draft response as the response from the response creator to the contra-party.

References

The references relied upon by the examiner are:

Sloo 5,895,450 Apr. 20, 1999

Burchetta 6,330,551 Dec. 11, 2001
(Filed Aug. 06, 1998)

“Online Mediation Offered for Resolving E-Commerce Disputes”, Online Resolution, March 23, 2000.

Joel B. Eisen, “Are we ready for mediation in cyberspace?”, Brigham Young University Law Review, vol. 1998 n4, pp 1305-1358 (1998).

Rejections at Issue

Claims 1, through 6, 8, 9, 11 and 14 through 26 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The examiner's rejection is set forth on pages 6 through 9 of the answer. Claims 1 through 3, 5, 6, 8, 9, 14 through 19 and 21 through 24 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Burchetta in view of Sloo. The examiner's rejection is set forth on pages 9 through 14 of the answer. Claims 4, 11 and 25 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Burchetta in view of Sloo, "Online Mediation Offered for Resolving E-Commerce Disputes" and Eisen. The examiner's rejection is set forth on pages 14 through 16 of the answer. Claims 20 and 26 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Burchetta in view of "Online Mediation Offered for Resolving E-Commerce Disputes" and Eisen. The examiner's rejection is set forth on pages 16 through 18 of the answer. We note the final rejection also contained several rejections based upon 35 U.S.C. § 112, however the examiner withdrew these rejections on appeal, see page 4 of the answer. Throughout the opinion we make reference to the briefs, the answer and the final Office action for the respective details thereof.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellant and the examiner, and for the reasons stated *infra* we sustain the examiner's rejection of claims 1 through 3, 5, 6, 8, 9, 14

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Application No. 09/793,687

through 19 and 21 through 24 under 35 U.S.C. § 103 (a). However, we will not sustain the examiner's rejection of claims 1, through 6, 8, 9, 11 and 14 through 26 under 35 U.S.C. § 101, nor will we sustain the examiner's rejection of claims 4, 11, 20, 25 and 26 under 35 U.S.C. § 103.

**Rejection of claims 1, through 6, 8, 9, 11 and 14 through 26
under 35 U.S.C. § 101.**

Appellant argues, on page 15 of the brief, that each of the independent claims recites steps performed on a computer, an apparatus, thus the claims are drawn to statutory subject matter. On pages 1 and 2 of the reply brief, appellant argues that the examiner's rejection is improperly based upon a "technological arts" standard.

The examiner's rejection, on pages 6 through 9 of the answer, applies a technological arts standard. Further, on pages 8 and 9 of the answer, the examiner finds that the claims are drawn to subject matter which "produces a useful, concrete and tangible result" nonetheless the examiner maintains the rejection as the claims are not within the technological arts. On page 18 of the answer, the examiner states that the claims recite the limitation "at a computer" not "on a computer" as such the claims are broad and include the situation where a person sitting at a computer manually performs the steps, thus the examiner considers the claims to not be within the technological arts.

We disagree with the examiner's rationale. As stated in our recent precedential decision in *Ex parte Lungren*, 76 USPQ2d 1385 (Bd. Pat. App. & Int. 2005), "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under §101" *Lungren* at 76 USPQ2d 1388. The appropriate analysis for a rejection under §101 can be found in the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, 1300 Off. Gaz. Patent and Trademark Off. (O.G.) 142, 152 (Nov. 22, 2005). Thus, as the examiner's basis for rejecting the claims under §101 is based upon a "technological arts" test which

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is not judicially recognized, we will not sustain the examiner's rejection of claims 1 through 6, 8, 9, 11 and 14 through 26 under 35 U.S.C. § 101.

Rejection of claims 1 through 3, 5, 6, 8, 9, 14 through 19 and 21 through 24 under 35 U.S.C. § 103 (a) as being unpatentable over Burchetta in view of Sloo.

Rejection of claims 1 through 3, 5, 6, 8, 9, and 14 through 19.

Appellant's arguments, on pages 15 through 17 of the brief, group claims 2, 3, 5, 6, 9 and 14 through 19 together with claim 1. Appellant argues on page 17 of the brief that the combination of Burchetta and Sloo is "improper; Burchetta's system already has a procedure for computing a settlement account []and there is nothing in Burchetta that would motivate one of ordinary skill in the art to substitute a teaching from Sloo for Burchetta's carefully designed procedure." Further, appellant argues:

Burchetta has a complete system for obtaining a settlement amount, involving a computed procedure for arriving at an amount; this is *imposing* a solution rather than *suggesting* a solution. Sloo is not really concerned with how complaints are settled, but nevertheless provides an elaborate arbitration system for deciding complaints. Arbitration does not *suggest* a solution as required by claim 1, instead, arbitration *imposes* a solution. Accordingly, the references themselves do not show or suggest the invention of claim 1. [Emphasis added]

The examiner responds, on pages 19 through 27 of the answer, asserting that the motivation can be found in Sloo's teaching of providing the highest satisfaction levels to the parties when settling the claims. Further, on pages 20 through 26 of the answer, the examiner equates the teachings of Burchetta and Sloo with the invention as claimed in claim 1.

We concur with the examiner's rationale as set forth on pages 20 through 26 of the answer. "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." *In re Huston* 308 F.3d 1267, 1278, 64 USPQ2d 1801, 1810 (Fed. Cir. 2002, citing *In re Kotzab* 217 F.3d 1365, 1370, 55 USPQ 1313, 1317 (Fed. Cir. 2000)). When considering the motivation in the obviousness

analysis “the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). The examiner’s rationale shows that the nature of the problem to be solved by Sloo provides the motivation to combine the reference. Further, we note that Sloo’s explicit statements regarding the use of a negotiation system also provide motivation to combine the references as asserted by the examiner.

Sloo teaches a system for complaint resolution, which contains several options, one of which is “Negotiate the Complaint.” See Sloo, column 7, line 42. Sloo teaches that the negotiations result in a settlement of either a monetary value or contract condition. See column 7, line 66 through column 8, line 5. Sloo however provides few details of how the negotiations are to be conducted. We consider this teaching of a negotiation option to provide suggestion to use Sloo’s system with a negotiation to settlement system such as Burchetta. Thus, in addition to the reasons stated by the examiner, we find that Sloo provides explicit motivation to be combined with a system such as Burchetta’s. Accordingly, we find ample evidence of record to support the examiner’s finding of motivation to combine Sloo and Burchetta.

With regard to appellant’s arguments directed to Burchetta and Sloo’s systems not providing suggestions to the users, we concur with the examiner’s analysis provided on pages 24 through 26 of the answer. We further note that in addition to the “imposed” solution referred to in appellant’s arguments, we find that both Sloo and Burchetta provide suggestions to the user. Sloo teaches, in column 15, lines 34 through 36, “[t]he complaint handling apparatus could recommend best actions.” We consider a recommendation to be a suggestion, and as such we find that Sloo teaches that the system provides suggestions to the user. Burchetta teaches that data from previous settlements may be tabulated and provided to the user as guidance in making demands or offers. See column 5, lines 51 through 65. We consider guidance to be a suggestion and as such Burchetta provides suggestions to the user.

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On pages 2 and 3 of the reply brief, appellant argues that neither Burchetta nor Sloo teach the claimed feature of “at least two of historical information, advisory information and contra-party current position information.”

We are not persuaded by appellant’s arguments. Burchetta teaches a system where parties to a dispute enter their offers to settle the dispute, the offers are not disclosed to the other party. See column 1, lines 55 through 67. The offers from each party are compared to each other using pre-established conditions. See column 2, lines 18 through 40. The users can enter three offers, see column 4, lines 48 through 51. After each round the parties are notified of the result of the comparison. See column 9, lines 49 through 52. We consider the notification of the user that their offer was not accepted to be an indication of contra-party current position (an indication an offer is not accepted along with the knowledge of the amount of the refused offer, provides information concerning the contra-parties position). Further, as stated *supra*, the system also provides information related to prior settlements available to the users, i.e. historical information. Thus, we find that Burchetta teaches “at least two of historical information, advisory information and contra-party current position information.”

For the forgoing reasons, appellant has not persuaded us of error in the examiner’s rejection of claim 1. Accordingly, we sustain the examiner’s rejection of claim 1 and the claims appellant grouped with claim 1, claims 2, 3, 5, 6, 9 and 14 through 19.

Rejection of claim 21

On pages 18 and 19 of the brief, appellant presents a separate argument directed to the rejection of claim 21. Appellant argues on page 18 of the brief:

Burchetta’s system does not generate a complaint remedy offer as required by claim 21. Instead, under pre-established condition, Burchetta’s system computes a settlement amount that is not one of the numbers entered by the users (column 4, lines 54-67). The parties cannot disagree with Burchetta’s computed settlement amount, so it is not an offer.

Further, appellant argues that Sloo does not teach this limitation.

We are not persuaded by appellant's argument. We note that Burchetta compares each party's offer with the counter party's offer of the same number, i.e. each party's first offer is compared, if there is no match, each party's second offer is compared. See Column 4, lines 48 through 52. The parties can enter all of the offers at once or over time. See Column 7, lines 29 through 35. If as discussed *supra* there is no match for the given round the system moves to the next round and the parties are notified. In the situation where the first party enters all three offers at once and the second party enters the offers at the beginning of each round, the first party's offers, will be stored in the computer, at the beginning of the second or third round, the computer will be generating an offer from the first party's previously entered data, to the second party on behalf of the first party. Thus, we find that Burchetta does generate a complaint remedy offer as required by claim 21 and we sustain the examiner's rejection of claim 21.

Rejection of claims 22 through 24.

Appellant's arguments, on pages 19 and 20 of the brief, group claims 22 through 24. Appellant states that Sloo teaches a "Request a Judge/Jury" option and that the monitoring of compliance teaching is directed to monitoring compliance with the judgments entered by the "Request a Judge/Jury" option. Appellant argues that a judgment is not an agreement that is voluntarily entered into and as such Sloo does not teach the limitation of "monitoring, at the computer, compliance by at least one of the complainant and the respondent with terms of the agreement."

While we concur with the appellant that Sloo teaches a "Request a Judge/Jury" option we do not find that one skilled in the art would consider Sloo's monitoring compliance as limited to just judgments from the judge and jury. Sloo states, in column 11, lines 45 through 53:

For example assume that a dispute was resolved using any of the *previous routines* described above, a judgment was rendered that required the subject to reimburse the complainant for damaged merchandise, and the subject failed to comply with the judgment. (emphasis added)

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However, Sloo identifies one of the routines as “Negotiate the Complaint” as discussed *supra*. We consider that one skilled in the art would recognize that Sloo in referring to monitoring compliance with a “judgment” also includes monitoring compliance with a negotiated settlement from the “Negotiate the Complaint” routine. Thus, we find that Sloo does teach the limitation of “monitoring, at the computer, compliance by at least one of the complainer and the respondent with terms of the agreement.” As appellant has not convinced us of error in the examiner’s rejection of claim 22 and the claims grouped therewith, we sustain the examiner’s rejection of claims 22 through 24.

Rejection of claims 4, 11, and 25 under 35 U.S.C. § 103 (a) as being unpatentable over Burchetta in view of Sloo, “Online Mediation Offered for resolving E-Commerce Disputes” and Eisen.

Appellant’s arguments, on pages 20 through 22 of the brief, group claims 4, 11 and 25 together. Appellant argues, on page 20 of the brief, that Burchetta teaches away from being modified to make use of emotional information. Appellant states that Burchetta teaches an advantage of the system is that it avoids direct communication between the parties and “[w]asteful personality conflict[s], fruitless and unnecessary disagreements, posturing and positioning cannot occur.” Further, on page 21 of the brief appellant argues, “Online Mediation Offered for resolving E-Commerce Disputes” and Eisen both discuss mediation where there is a human mediator who receives the emotional information and performs the emotional management.

We concur with the appellant. Our reviewing court has said “[A] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be lead in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend upon the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” *In re Gurley*, 27 F.3d

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551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) (*citing United States V. Adams*, 383 U.S. 39, 52, 148 USPQ 478, 484 (1966)). However, a reference that “teaches away” does not *per se* preclude a *prima facie* case of obviousness, but rather the “teaching away” of the reference is a factor to be considered in determining unobviousness. *Id.* 27 F.3d at 552, 31 USPQ 2d at 1132. We find, as appellant asserts that one of the stated purposes of Burchetta is to deal exclusively with the bottom line, and prevent personality conflicts, unnecessary disagreements, posturing and positioning. See column 5, lines 1 through 8. Claim 4 recites: “receiving emotional detail information.” Claims 11 and 25 contain similar limitations. We consider this to be information relating to the feelings of the user and not information directed to the contents of the offer. See for example appellant’s specification on page 14, lines 22 through 30. We consider this to be at odds with Burchetta’s teaching of dealing exclusively with the bottom line and avoiding the emotional aspects of negotiating. Further, we do not find that the disclosures of Sloo, “Online Mediation Offered for resolving E-Commerce Disputes” and Eisen present sufficient suggestion that Burchetta’s system should be modified in the face of the teaching away. Accordingly, we will not sustain the examiner’s rejection of claims 4, 11, and 25.

Rejection of claims 20 and 26 under 35 U.S.C. § 103 (a) as being unpatentable over Burchetta in view of “Online Mediation Offered for resolving E-Commerce Disputes” and Eisen.

Claim 20 recites the limitation “receiving, at a computer, emotional detail information from the complainer,” claim 26 is dependent upon claim 20. As discussed *supra*, with respect to claim 4, we find that Burchetta provides strong suggestion away from using such information and that we do not find that “Online Mediation Offered for resolving E-Commerce Disputes” and Eisen present sufficient suggestion that Burchetta’s system should be modified in the face of the teaching away. Accordingly, we will not sustain the examiner’s rejection of claims 20 and 26 for the reasons stated *supra* with respect to claim 26.

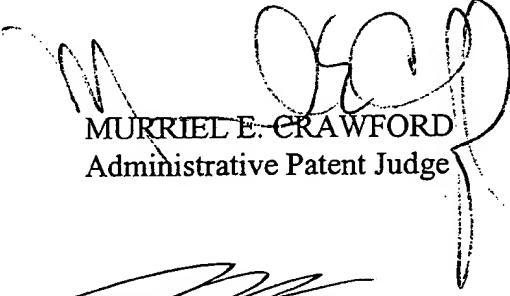
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Conclusion

In summary, we sustain the examiner's rejection of claims 1 through 3, 5, 6, 8, 9, 14 through 19 and 21 through 24 under 35 U.S.C. § 103 (a). However, we will not sustain the examiner's rejection of claims 1, through 6, 8, 9, 11 and 14 through 26 stand rejected under 35 U.S.C. § 101, nor will we sustain the examiner's rejection of claims 4, 11, 20, 25 and 26 under 35 U.S.C. § 103. The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART



MURRIEL E. CRAWFORD
Administrative Patent Judge

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